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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,114	11/25/2003	Michael Z. Hoemann	SPV-048.02	4865

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FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
155 SEAPORT BLVD  
BOSTON, MA 02110

EXAMINER
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DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,114	<b>Applicant(s)</b> HOEMANN, MICHAEL Z.	
	<b>Examiner</b> Rita J. Desai	<b>Art Unit</b> 1625	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 92-108 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 101-108 is/are allowed.
- 6) ☒ Claim(s) 1 and 92-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

Claims 1, 9-10 were pending. Applicants have added claims 101-108.

Applicants need to amend the claims to include the R being only non heteroring groups.

The rejection of claims 1 and 92 over Rehse et al DN 106:183327 under 35 U.S.C.

103 still stands. A difference of one  $-CH_2-$ , makes a compound a homolog and homologs are considered to be a prima facie obvious variant.

Claims 92 now has R2 being R6(O)alkyl- applicants arguments in the previous response

*"the definition of R2 in claims 1 and 92, amended claims 1 and 92 do not read on compounds A and B of Rehse et al.*

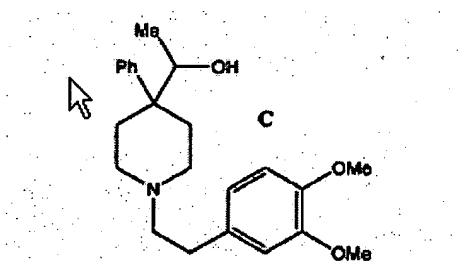
*The definitions of R2 in claims 1 and 92 have also been amended to replace Ro-alkyl*

*with RO-CH<sub>2</sub>. l-Hydroxyethyl (-CH(OH)CH<sub>3</sub>) is the group in **compound C** corresponding to R2 in claims 1 and 92. l-Hydroxyethyl (-CH(OH)CH<sub>3</sub>) corresponds to Ro-alkyl, wherein R is H;*

*and alkyl is ethyl. Because Ro-alkyl has been removed from the definitions of R2 in claims 1"*

Applicants previous arguments are now no longer valid.

Compound C in the Rehse et al reference is given by



The phenyl R5 group is substituted and R2 in claim 1 is ROCH<sub>2</sub>- , and in claim 92 is R6Oalkyl- Replacing a hydrogen with an alkyl group is prima facie obvious in the absence of a showing of unexpected results.

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The rejection under 35 USC 102(b) over DN 94:57952 has been withdrawn for claim 1 and 92 , as applicants have amended the claims. However this rejection is also changed to a 103 .

Applicants have deleted the H but the alkyl group is still remaining and H verses alkyl is prima-facie obvious. Applicants do not have any showing of unexpected results. See the above 103 rejection.

The rejection under 35 USC 102(b) over DN 54:39146, GB 817357 has been withdrawn because the compounds have a COOH group for the R2 .

Applicant's amendment necessitated the new ground(s) of rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 92, 94,98 and 100 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no mention of R6 in the specifications, also there is no definition of the term.

### ***Conclusion***

The claims are not found to be allowable.

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Applicants should note that their definition of aryl is inconsistent with the normal meaning and it can include all hetero aryls too.

The restriction limits it to the non-hetero groups.

Claims 101-108 are found to be allowable limited to the elected group.

Claims 1, 92-100 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai  
Primary Examiner  
Art Unit 1625

*R. Desai*  
8/14/06

R.D.

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August 14, 2006